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488

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/197,908 - 11/23/98 - HERBST

A	NEWMARKTP98-1
EXAMINER	

TM02/0302

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PART UNIT, Y	PAPER NUMBER
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DATE MAILED:

03/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

488

Office Action Summary

Application No.
09/197,908

Applicant(s)
Herbst et al.

Examiner
Yehdega Retta

Group Art Unit
2162



☒ Responsive to communication(s) filed on Dec 4, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-20 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Amendment

1. This office action is in response to amendment filed April 03, 2000.

Response to Arguments

2. Applicant's arguments with respect to claims 1-20 have been considered but are moot in view of the new ground(s) of rejection.

Based on Applicant's remarks to the 112 second paragraph rejection, "preferred-return instruments" is interpreted as "preferred stock". And according to the definition submitted by applicant, preferred stock is a stock that carries a fixed, specific dividend and that takes precedence over dividends to holders of common stock; it also has a prior claim on the assets of the firm and, as such, is senior to common stock.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the

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art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

5. Regarding claims 1, 19 and 20, the disclosure failed to teach financial characteristics sufficient for computing a price for preferred-return instruments (preferred stock), the amount that buyers wants to buy or sell...at respective buyer's hypothetical current preferred return. The disclosure also fails to teach computing a supply and demand schedule for each instruments and comparing the schedules to produce the current preferred return and computing the price for each instrument having a current preferred return. The specification in page 17, 18 and 19, discloses entering a sell or a buy order, retrieving the stored buy or sell order, computing a demand or supply schedule and determining if auction criteria are met. The disclosure however fails to state or teach one of ordinary skill the exact amount or number or value used which is considered sufficient for computing the price for the preferred-return instrument. The disclosure also failed to state or teach what type of criteria is met, what type of demand or supply is computed. Since different financial characteristics and amount or value can be used to perform different kind of auctions, and since different hypothetical current preferred return can be drawn, without these disclosure, one of ordinary skill can not practice the invention without undue experimentation.

6. Regarding claims 16-18, the disclosure fails to teach data consisting of a price and a preferred rate of return and utilizing the data in generating respective amounts of preferred-return instruments. The disclosure fails to state or teach what data is utilized in generating the respective amounts of the instruments, and what is considered respective amount. Without this disclosure,

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one of ordinary skill can not practice the invention without undue experimentation because of the number of parameters that could be utilized in order to generate different amounts or values of instrument.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. The term "financial characteristics sufficient for computing a price" in claims 1, 19 and 20 is a relative term which renders the claim indefinite. The term "sufficient financial characteristics" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

9. Claims 2-15 are rejected because by their dependence they include the language of a rejected base claim.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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12. Claims 1, 19 and 20, recite: entering financial characteristics sufficient for computing a price for preferred-return instruments; amounts that buyers or seller wants to buy or sell...; computing a price for each instrument (preferred stock); and generating output including respective amounts of the instruments. Applicant's disclosure does not clearly state what kind of financial characteristics are used to compute the price and what output are generated and what the respective amounts are. In light of the specification, Examiner could not understand the limitations recited in the claims. Applicant's specification, as stated above does not state or teach the amounts or financial characteristics that define the preferred-return instrument.

13. Claims 16-18 recites a respective amount of the instrument (preferred stock). Applicant's specification does not clearly show what the respective amount of the instrument is, therefor is not clear what applicant's regards as an invention.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Nelson, U.S. Patent No. 4,823,265, Renewable option accounting and marketing system.

Odem et al. U.S. Patent No. 6058379, real-time network exchange with seller specified exchange parameters and interactive seller participation.

Chou et al. U.S. Patent No. 6035289, method and apparatus for electronic trading of carrier cargo capacity.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yehdega Retta whose telephone number is (703) 305-0436. The examiner can normally be reached on Monday-Friday from 7 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703) 305-8469.

Any response to this office action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

(703) 308-9051, (for formal communications intended for entry)

or:

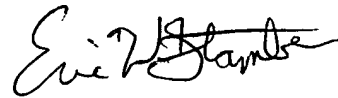
(703) 308-5397, (for informal or draft communications, please label "PROPOSED" or "DRAFT")

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Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive Arlington, Virginia, (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Examiner
Yehdega Retta
Art Unit 2162
February 28, 2001



ERIC W. STAMBER
PRIMARY EXAMINER